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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,122	01/29/2002	Philip B. Sample	00167-455001	3500

7590 04/14/2006  
JOEL R. PETROW  
Smith & Nephew, Inc.  
1450 Brooks Road  
Memphis, TN 38116

EXAMINER

BAXTER, JESSICA R

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/058,122	<b>Applicant(s)</b> SAMPLE, PHILIP B.	
	<b>Examiner</b> Jessica R. Baxter	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.  
 4a) Of the above claim(s) 4,7-10,20,22,31,32,34-36 and 38 is/are withdrawn from consideration.  
 5) ☒ Claim(s) 27-30 and 33 is/are allowed.  
 6) ☒ Claim(s) 1-3,5,6,11-19,21 and 23 is/are rejected.  
 7) ☒ Claim(s) 24-26 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01292002</u> . | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Species 2a, 3ai, 3bi, 3ci and 3dii in the reply filed on 19 December 2005 is acknowledged. The traversal is on the ground(s) that some subspecies are not separate subspecies. This is not found persuasive because the applicant does not indicate which species are the same and does not specifically point out the error in the Examiner's listing of subspecies.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 4,7-10,20,22,31,32,34-36 and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subspecies, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 19 December 2005.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3,5,6,11-18 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,309,394 to Staehlin et al.

Staehlin discloses a tissue cutting instrument, comprising: an outer member (560); an inner member (560) received within the outer member; and a cutter (514) coupled to the

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inner and the outer members such that rotation of the inner member about an axis causes off-axis movement of the cutter (Column 11, lines 36-49); wherein the outer member includes a terminal end at a distal end; wherein the terminal end is spherical (FIG. 15A), wherein the terminal end defines an opening therein (FIG. 15 A, opening at distal end), the terminal end opening including a cutting portion; the terminal end opening is formed by a cut into the terminal end, wherein the outer member includes a first chamber and a second chamber (534,518), the chambers being located in an inner surface of the terminal end of the outer member; wherein each chamber is arch-shaped (FIG. 11); wherein the cutter comprises a first shaft and a second shaft (520), each shaft of the cutter assembling in a respective one of the chambers (FIG. 11), wherein the inner member includes a plurality of teeth at its distal end (on gear 550); wherein the inner member rotates axially and the cutter rotates in a direction perpendicular to the direction of rotation of the inner member (Column 11, lines 36-49); wherein the cutter comprises a hollow body (FIG. 11), the body defining an opening therethrough; wherein the body comprises a sphere (FIG. 13A-13D); wherein the cutter opening comprises a cutting portion and an extended portion (FIG. 13D); wherein the cutter comprises a first shaft and a second shaft, the shafts being located 180° apart from each other along an outer surface of the cutter (axles 20).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staehlin et al. '394

Claims 19 and 21 are not given patentable weight because they are product-by-process type claims. Though the claims recite the process by which the surgical component is made, they are still product claims. Only the structure of the product determines whether it is known in the art or it is obvious; the process by which the structure of the surgical device is made does not govern whether a product is patentable. Molding and cutting a cutter are only manufacturing options, and the same structure for the device can be obtained by either of these methods.

***Allowable Subject Matter***

7. Claims 27-30,33 and 37 are allowed.
8. Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R. Baxter whose telephone number is 571-272-4691. The examiner can normally be reached on M-F 8:30AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica R Baxter  
Examiner  
Art Unit 3733

  
JRB

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER